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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/196,161 11/20/98 SIN

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HM22/0306

EXAMINER

LEE, L

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ART. UNIT

PAPER NUMBER

1645

10

DATE MAILED: 03/06/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/196,161

Applicant(s)
Yoke Min Sin et al

Examiner
Li Lee

Group Art Unit
1645



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-23 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-23 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-8, drawn to a vaccine comprising a recombinant fusion protein derived from *Ichthyophthirius multifiliis*, classified in class 530, subclass 350.
 - II. Claims 9-13 and 17-21, drawn to a method of immunizing fish against ciliated ectoparasitic protozoans comprising treating said fish with the protein vaccine derived from *Ichthyophthirius multifiliis*, classified in class 514, subclass 12.

Claim 21 is grouped with Group II, which is assumed by the examiner containing a typographic error of "claim 7" for "claim 17" in the claim 21.
 - III. Claims 14-16, drawn to a method of producing a protein vaccine against ciliated ectoparasitic protozoans, classified in class 435, subclass 71.1.
 - VI. Claims 22-23, drawn to a synthetic nucleic acid sequence, classified in class 536, subclass 23.1.
2. The inventions are distinct, each from the other because of the following reasons:
3. The Groups I and VI are related as products. The claims of Group I are drawn to isolated polypeptide while those of Group II are drawn to a polynucleotide. The inventions can be shown to be distinct because they are physically (e.g., amino acids versus nucleic acid) and functionally (e.g., mediate biological activity versus encode proteins) distinct chemical entities.

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4. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the purified protein derived from *Ichthyophthirius multifiliis* in Group I can be used in materially different methods such as detecting a antibody in vitro assays.
5. Inventions I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the protein vaccine of Group I can be made by another and materially different process such as purified from the parasite cells of *Ichthyophthirius multifiliis* rather than recombinant gene expression technics.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter as shown by the different classification, and absent restriction would place an undue search and examination burden on the examiner, therefore restriction for examination purposes as indicated is proper.

Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1645 by facsimile transmission. The faxing of such papers must conform with the notice


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published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Li Lee whose telephone number is (703) 308-8891. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached at (703) 308-3995.

Li Lee

February 28, 2000


PRIMARY **ALBERT NAVARRO**
PATENT EXAMINER